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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,368	01/10/2002	Thomas E. Broome	1001.1388101	8240

28075 7590 10/01/2004

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EXAMINER

PANTUCK, BRADFORD C

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,368

Applicant(s)

BROOME ET AL.

Examiner

Bradford C Pantuck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-51 is/are pending in the application.
- 4a) Of the above claim(s) 5-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 32-51 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,565,591 B2 to Brady et al. Regarding Claim 1, Brady discloses a filter system that catches debris within a blood vessel [Column 3, lines 37-41]. The assembly includes an elongate shaft (2) and a filter (41/47/57) disposed on the distal end of the shaft. The filter has a first tapered portion (57) having an apex at its distal end and a base diameter at its proximal end. The filter has a second tapered portion, as well [see Attachment #1].

The base diameter (labeled in Attachment #1) of the first tapered portion is similar to an inner diameter of a retrieval sheath, such as the catheter used to deliver the prior art embolism protection device. The reader knows that this is so because Brady explains that component 61 [see Fig. 1; Column 4, lines 46-51] is sized to fit the lumen of a delivery catheter and said component 61 is has a just slightly smaller diameter than the base diameter of the first tapered portion.

Regardless, Applicant does not positively recite the retrieval sheath or claim the sheath as a part of the invention.

2. Regarding Claim 33, the filter is collapsible [Column 3, lines 37-40], and therefore has an expanded shape and a contracted shape.
3. Regarding Claim 34, the first tapered portion (47/57) has a conical shape, which is the shape of component (57) [see Fig 5].
4. Regarding Claim 35, Brady's second tapered portion (part with holes 51) has a frustaconical shape.
5. Regarding Claims 36 and 37, Brady's filter includes a membrane [Column 1, lines 61-62] and in one embodiment, the membrane is made out of polyurethane [Column 5, line 16].
6. Regarding Claim 38, the membrane (41) includes a plurality of apertures (51) [Fig. 1].
7. Regarding Claims 39-45, Brady's frame is made out of Nitinol [Column 4, lines 9-14] and is capable of biasing the filter into an expanded position.
8. Regarding Claim 46, Brady discloses a retrieval catheter for retrieving the filter [Column 4, lines 60-63].
9. Regarding Claim 47, for the filter to fit inside of the retrieval catheter, each tapered portion (and the whole filter) must have a small diameter than the catheter.
10. Regarding Claim 48, the catheter fits snugly inside of a catheter [Column 11, lines 39-44], and therefore the compressed diameter of the first portion is similar to the retrieval sheath/catheter.

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11. Regarding Claim 49, the first diameter of the second tapered portion [see Attachment #1 from Non-Final Rejection dated 04/24/2004] is the same dimension as the base diameter of the first tapered portion.
12. Regarding Claim 50, Brady discloses a limiter (47) that is cylindrical and keeps the base diameter of the first taper at a diameter that is the same as the inner diameter of the delivery catheter.
13. Regarding Claim 51, gold loop (59) keeps the first tapered portion from being compressed too much, maintaining its diameter at about the same diameter as the inner diameter of the retrieval sheath.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Response to Arguments

15. Applicant's arguments filed June 15, 2004 have been fully considered but they are not persuasive. Brady discloses all of the claimed features of the invention. Both of the portions of Brady's filter are tapered. Specifically, in Column 4, lines 35-40, Brady explains, "guide olive 57 forms an extension of the distal end 47 of the filter body 41 and tapers distally inwardly for a smooth transition profile." Portion 57 is therefore *a part of the filter 41* and "tapers...inwardly," confirming that what the Figures show is accurate. Brady's first portion has both a tapered portion 47 and a cylindrical portion 57 ("limiter"). Brady's second portion (the part of the filter with the holes 51) evident in Fig. 1 is clearly shown to taper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (703) 308-2154. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BCP

BCP

September 23, 2004


ANH TUAN T. NGUYEN
PRIMARY EXAMINER

9/28/04